

REMARKS

Applicant has carefully studied the Final Office Action of February 25, 2004 and offers the following remarks thereto.

The pending claims were rejected under 35 U.S.C. § 103. However, in constructing the rejections, the Patent Office has overlooked three very important limitations on creating obviousness rejections under 35 U.S.C. § 103. First, the references must be analogous. The test for analogously is set forth in MPEP § 214.01(a). The reference must be in the same field of endeavor as the invention. A reference may still be analogous if, even though it is not in the same field of endeavor if the reference logically commends itself to an individual faced with the same problem as that confronting the inventor. Second, the Patent Office must articulate a reason to combine the references. This is sometimes referred to as the motivation to combine the references. When the Patent Office articulates a motivation to combine the references, the Patent Office must support this motivation with actual evidence. *In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999). While the law allows for multiple sources of this evidence, the fact that the motivation can come from the knowledge of one of ordinary skill in the art does not diminish the need for actual evidence to support the motivation. *Id.* Interestingly, the Patent Office's own citations support the need for actual evidence. Specifically, on page 16 of the Office Action, the Patent Office quotes *In re Lee*, 277 F.3d 1365, 1370 (Fed. Cir. 2002) for the proposition that it is important to rely on objective evidence and making specific factual findings with respect to the motivation to combine references. This underscores the importance of providing actual evidence, even when the motivation comes from the general knowledge of one of ordinary skill in the art. Third, once the references are combined, the combination must teach each and every element of the claim, or the Patent Office has not established *prima facie* obviousness. MPEP § 2143.03.

Applicant previously argued that Ushiku did not teach that the skeleton definition language was adapted to function as a directive for control of a transformation. Herein, Applicant amends the independent claims to clarify that this transformation is the transformation of the skeleton description into a skeleton tool. While this was implicit in the claims previously presented, the amendment further emphasizes the connection between the two elements. As this element was implicitly present previously, this does not constitute a new issue and no additional search should be required. MPEP § 904.

Claims 1-5, 18-25 were rejected under 35 U.S.C. § 103 as being unpatentable over Logan et al. (hereinafter "Logan") in view of Caughran et al. (hereinafter "Caughran") and further in view of Ushiku. Applicant respectfully traverses.

Initially, Applicant objects to the use of Ushiku as non-analogous art. Ushiku is directed to publishing email (see title or abstract). Applicant is concerned with testing software, and particularly, testing software used in telephone switches. As such, Ushiku is not in the same field of endeavor. Since Ushiko is not in the same field of endeavor, Ushiku fails the first prong of the test for analoguousness. Further, Applicant was confronted with the problem of trying to test a software suite for a telephone switch. A reference that is designed for selectively publishing email does not readily suggest itself to someone trying to test a software suite for a telephone switch as being a relevant reference. To this extent, Ushiku fails the second part of the test for analoguousness. It appears that the Patent Office has performed an electronic word search, found the key phrase "skeleton language," and ignored the rest of the context of the reference. When the context of the citation to Ushiku is considered, the reference is clearly non-analogous. Since the reference is non-analogous, the reference is not available to be cited against the claims. Since the reference is not available to be cited against the claims, and the Patent Office admits that the combination of Logan and Caughran does not teach or suggest all the claim elements, the rejection fails to establish *prima facie* obviousness and the claims are allowable. Applicant requests withdrawal of the § 103 rejection of claims 1-5 and 18-25 at this time on this basis.

Even if Ushiku is analogous, the Patent Office has not satisfied its burden in proving obviousness. The Patent Office initially combines Logan with Caughran on the premise that this modification suggests that the manual decomposition feature of Caughran can be systematically automated by the Logan system that exposes component features in a test environment which generates a test case code as taught by Logan at col. 7, lines 39-46. Applicant specifically traverses this motivation to combine the references as inappropriate. The Patent Office assumes that the combination is made *a priori*, and then says that the modification to the combination is obvious after the two references are combined. Modification of a combination after the combination is assumed is not the correct standard. The motivation to combine the references must be present before the combination. While the case law says that the motivation to combine the references must come from one of three sources (the knowledge of one of ordinary skill in

the art, the references, or from the nature of the problem to be solved), the case law goes on to say that the motivation to combine the references must be supported by actual evidence. *In re Dembicza*k at 999. If the Patent Office cannot come up with a reason to combine the references other than that after combination, the combination suggests a modification, then the Patent Office has not properly supported the motivation to combine the references. Thus, even though the Patent Office has provided a citation to a portion of one of the references, the Patent Office has not provided the requisite actual evidence to support the motivation to combine the references. Merely because a combination is possible and the combination may suggest a modification does not equate to a suggestion to combine the references in the first place. MPEP § 2143.01. The Patent Office must show that the combination is desirable before it can go on to opine that the combination suggests a modification. *Id.*

The Patent Office compounds its error when the Patent Office combines Ushiku with the other references. The Patent Office again says that the combination of the three references suggests the modification, but does not give any reason to combine the three references in the first place. This constitutes error in the creation of the combination, and the combination is improper. Since the combination is improper, the rejection fails and the claims are patentable.

Finally, even if the combination of references is proper, the combination fails to show each and every claim element. While this was true of the claims before amendment, the amendments to the independent claims highlight that the skeleton definition language that controls a transformation controls the transformation of the skeleton description into a skeleton tool. As noted above, this was implicit in the claims before amendment, but is not explicit. In contrast, the skeleton of Ushiku is for generating published pages. If the Patent Office extracts just the concept of the skeleton from Ushiku, this extraction renders Ushiku unsuitable for its intended purpose. Specifically, if the skeletons of Ushiku are modified to create skeleton tools, then Ushiku is no longer suitable for publishing a page. The MPEP instructs the Patent Office that a combination that renders a reference unsuited for its intended purpose supports a finding of non-obviousness. MPEP § 2143.01. Since the proposed combination and modification renders Ushiku unsuitable for its intended purpose, the combination is improper and the claims are patentable over the rejection of record.

Claims 6-9, 15, and 16 were rejected under 35 U.S.C. § 103 as being unpatentable over Logan in view of Caughran in view of Ushiku and further in view of Kirsch. Applicant

respectfully traverses. This combination relies on the same combination of Logan, Caughran and Ushiku addressed above. The addition of Kirsch does not cure the deficiencies of the underlying combination. To this extent, this rejection is flawed as well, and the claims are patentable thereover.

Claims 10-14 were rejected under 35 U.S.C. § 103 as being unpatentable over Logan in view of Caughran in view of Ushiku in view of Loukianov and further in view of Kirsch. Applicant respectfully traverses. This combination relies on the same combination of Logan, Caughran and Ushiku addressed above. The addition of Kirsch and Loukianov does not cure the deficiencies of the underlying combination. To this extent, this rejection is flawed as well, and the claims are patentable thereover.

Claim 17 was rejected under 35 U.S.C. § 103 as being unpatentable over Logan in view of Caughran and further in view of Ushiku and Ahanessians et al. (hereinafter "Ahanessians"). Applicant respectfully traverses. This combination relies on the same combination of Logan, Caughran and Ushiku addressed above. The addition of Ahanessians does not cure the deficiencies of the underlying combination. To this extent, the rejection is flawed as well, and the claim is patentable thereover.

Applicant adds new claim 26. New claim 26 incorporates the subject matter of claims 1, 2, 10, 15, and 16. Claim 16 is canceled as redundant in light thereof. The total claim count is the same, but Applicant adds a new independent claim. Claim 26 includes the clarification as to the nature of the skeleton definition language and the transformation discussed above with respect to the other independent claims and thus is patentable at least for the same reasons. Likewise, Applicant respectfully opines that this recitation of the various elements from claims 1, 2, 10, 15, and 16 is not shown or suggested by the combination of references of record.

Applicant requests reconsideration of the rejection in light of the amendments and arguments presented herein and claim allowance at the Examiner's earliest convenience.

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